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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,452	06/10/2001	Kazuo Sugamura	2001-0572A	4276

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EXAMINER

HUNNICUTT, RACHEL KAPUST

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 08/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/831,452	<b>Applicant(s)</b> SUGAMURA ET AL.	
	<b>Examiner</b> Rachel K. Hunnicutt	<b>Art Unit</b> 1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☒ Claim(s) 3 and 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>0604</u> | 6) <input type="checkbox"/> Other: _____  |

### **RESPONSE TO AMENDMENT**

Applicant's amendment filed June 10, 2004 is acknowledged. Claims 4 and 6-14 have been canceled. Claims 1-3 are amended. Claims 1-3 and 5 are pending and under consideration. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

#### ***Claim Rejections/Objections Withdrawn***

The rejection of claims 1-3 under 35 U.S.C. 101 as being directed to non-statutory subject matter is withdrawn in response to Applicant's amendments to these claims. The rejection of claim 4 is withdrawn in response to Applicant's cancellation of this claim.

The rejection of claims 4 and 13 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, is withdrawn in response to Applicant's cancellation of these claims.

The rejection of claim 4 under 35 U.S.C. 102(b) as being anticipated by Yu *et al.* is withdrawn in response to Applicant's cancellation of the claim.

The rejection of claims 4 and 13 under 35 U.S.C. 102(b) as being anticipated by Andersson *et al.* is withdrawn in response to Applicant's cancellation of these claims.

#### ***Claim Rejections - 35 USC § 102***

Claims 1 and 2 are newly rejected under 35 U.S.C. 102(b) as being anticipated by Yu *et al.* Claim 1 is drawn to an isolated human protein having the amino acid sequence of SEQ ID NO: 1. Claim 2 is drawn to an isolated human gene encoding the human protein having the amino acid sequence of SEQ ID NO: 1. Yu *et al.* teach a nucleic acid sequence, GenBank Accession No. AF052135, that encodes a protein which is 100% identical to SEQ ID NO: 1 (see attached alignment). Thus, Yu *et al.* teach an isolated human gene encoding a protein having the amino acid sequence of SEQ ID NO: 1. The amino acid sequence of SEQ ID NO: 1 is an

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inherent feature of AF052135 because one skilled in the art would be in possession of the sequence and be able to envision it once he or she had possession of the nucleic acid sequence.

Claims 1 and 2 are anticipated by Yu *et al.*

### ***Conclusion***

Claims 3 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1 and 2 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel K. Hunnicutt whose telephone number is (571) 272-0886. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RKH  
8/27/04

  
JANET ANDRES  
PRIMARY EXAMINER